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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,729	02/25/2004	Peter A. Rodriguez	S0720.10U	2737
29633	7590	12/21/2005	EXAMINER	
ROGERS TOWERS, P.A. 1301 RIVERPLACE BOULEVARD, SUITE 1500 JACKSONVILLE, FL 32207			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,729	RODRIGUEZ, PETER A.	
	Examiner	Art Unit	
	Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/25/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a self-adhering bale strapping band, classified in class 428, subclass 343+.
- II. Claims 23-29, drawn to a bale strapping band produced by the steps of providing a plurality of paper strips, classified in class 156, subclass various.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one wherein a bale strapping band is produced by providing a plurality of preformed paper strips, each was already folded to define two plies.
2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Mr. Thomas Saitta on 11/14/05 a provisional election was made without traverse to prosecute the invention of Group I,

claims 1-22 drawn to a self-adhering bale strapping band. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language of the claims 1 and 12 appears to be grammatically ambiguous so as not to clearly and accurately convey the spatial relationship of the paper strips. The recitation "a plurality of aligned paper strips" is not clear on how the paper strips are joined to each other. The paper strips are stacked one on top of another or the paper strips are aligned side by side along the side surfaces extending in the longitudinal direction. Various interpretations are possible but do not seem within the scope of the disclosed invention. With respect to the recitation "first external surface bonds to the second external surface through an external adhesive layer", the present Specification discloses the external adhesive used to secure two ends of the bale strapping band.

However, support for the recitation “the first external surface bonds to the second external surface by an external adhesive” is not fully found in the Specification of the present invention. Does applicant want to convey that two ends of the strapping bands are joined together via an external adhesive?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 11-19, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Peacock (US Patent Application Publication 2003/0235687 A1).

Peacock teaches a paper tape or strap that is used for cutting a continuous web or a paper and for binding bales of pulp from which paper is made (Paragraph 0003). Thus, peacock et al. are concerned with the packaging of bales of pulp. Regarding claims 1 and 12, the paper tape of Peacock's invention is formed from folding a paper web and utilizes a heat sensitive adhesive (Paragraph 0025) such that the adhesive covers the inside surfaces of the folded paper tape and the adhesive is also applied to at least one outer surface of the paper tape (Paragraph 0009). Thus, each outer surface of the paper tape can be bonded to each other. Alternatively, Figure 2, of Peacock shows folded paper tape that is bonded at the joint 22. Peacock teaches that heat seal is used

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to join the two ends of the tape but other methods can be used as known to those skilled in the art. According to Peacock, any number of folding operations could be performed in a variety of different ways as is known by one skilled in the art (Paragraph 0022) and two or more paper webs can be used to form the folded paper tape (Paragraph 0025). Regarding claims 1 and 12, Figure 1 of Peacock shows more than one internal ply between the outer surfaces of the folded paper tape of Peacock. The outer surfaces of the paper tape of Peacock reads on the external surfaces as claimed in the claimed subject matter.

With respect to claims 2 and 13, Figure 1 of Peacock shows more than one internal ply and the disclosure of Peacock at paragraph 0009 that adhesive covers the inside surfaces of the tape reads on claims 2 and 13.

Regarding claims 3 and 14, Peacock teaches polyvinyl alcohol as an adhesive. Polyvinyl alcohol is inherently water-soluble.

With respect to claims 4 and 15, the adhesive of Peacock is a heat sensitive adhesive (Paragraph 0024).

With respect to claims 5 and 16, according to Peacock, bale strapping tape utilized for bailing paper pulp is thoroughly re-pulpable (Paragraph 0006).

Regarding claims 6-8 and 17-19, at paragraphs [0022] and [0025], Peacock teaches that any number of folding operations could be performed in a variety of different ways as is known by one skilled in the art and other folds could be used as known to those skilled in the art and more or less fold could be performed. Additionally,

at paragraph [0025], Peacock teaches that two or more paper webs can be used to form the folded paper tape.

With respect to claims 11 and 22, the water-soluble adhesive of Peacock will inherently be absorbed into the outer surfaces of the adhesive paper tape of Peacock.

Therefore, it is the examiner's position that Peacock anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock (US Patent Application Publication 2003/0235687 A1) as applied to claims 1 and 12 above, in view of Herman et al. (US 3,308,006).

The invention of Peacock is previously disclosed. Peacock is silent as to teaching a corrugated internal support strip. However, Herman et al. teach an application of corrugated paperboards in the packaging industry. At column 1, lines 16-29, Herman et al. teach that in construction of corrugated paperboard, a corrugated sheet made from pulp is bonded to one or more monoplanar sheets (liners). Figure 2 of Herman et al. shows such a construction. According to Herman et al., the corrugated sheet (medium) of the paperboard functions to greatly enhance the strength of the finished paperboard (Column 1, lines 26-29). Note that the folded paper tape of

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Peacock has to be strong enough to be used in paper pulp bailing applications (See Paragraph 0011). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a corrugated internal ply/plies in the invention of Peacock, motivated by the desire to enhance the strength of the paper tape so that it can be used in the paper pulp bailing.

7. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock (US Patent Application Publication 2003/0235687 A1) as applied to claims 1 and 12 above, in view of Bartelmuss et al. (US 5,816,526).

The invention of Peacock is previously disclosed. Peacock is silent as to teaching a corrugated paper strip. However, the invention of Bartelmuss et al. is related to the paper production. Bartelmuss et al. teach a tear strip made of a paper (Column 1, lines 5-10). The tear strip is formed by folding a paper strip multiple times (Column 3, lines 5-8). According to Bartelmuss et al., the tear strip is corrugated which makes the tear strip flexible (Column 2, lines 39-41). Thus, it would have been obvious to one having ordinary skill in the art at the time the inventions was made to choose a S-folded corrugated paper web and formed the paper tape of Peacock, motivated by the desire to provide a flexible paper tape.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD



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PRIMARY EXAMINER